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FAX TRANSMISSION TO USPTO

TO: Assistant Commissioner for Patents
Attn: Examiner William L. Bashore
Patent Examining Corps
Facsimile Center
Washington, D.C. 20231

FROM: Victor G. Cooper
OUR REF.: ST9-98-052
TELEPHONE: (310) 642-4142

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Total pages, including cover letter: 6

PTO FAX NUMBER: 703/308-6306

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Title of Document Transmitted:	PETITION UNDER 37 C.F.R. §1.181.
Applicant:	Howard J. Glaser et al.
Serial No.:	09/162,685
Filed:	September 29, 1998
Group Art Unit:	2176
Our Ref. No.:	ST9-98-052

Please charge all fees to Deposit Account No. 09-0460 of IBM Corporation, the assignee of the present application.

By: 
Name: Victor G. Cooper
Reg. No.: 39,641

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.


Signature

May 18, 2001
Date

VGC/io

G&C 30571.179-US-01

RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2176

Due Date: May 22, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Howard J. Glaser et al.	Examiner:	William L. Bashore
Serial No.:	09/162,685	Group Art Unit:	2176
Filed:	September 29, 1998	Docket:	ST9-98-052
Title:	HTML MAPPING SUBSTITUTION GRAPHICAL USER INTERFACE FOR DISPLAY OF ELEMENTS MAPPED TO HTML FILES		

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being filed via facsimile transmission to the U.S. Patent and Trademark Office on May 18, 2001.By: Victor G. Cooper
Name: Victor G. CooperBOX AF
Commissioner for Patents
Washington, D.C. 20231**OFFICIAL**

Dear Sir:

We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
- ☒ PETITION UNDER 37 C.F.R. §1.181.
- ☒ Please charge in the amount of \$130.00 to Deposit Account No. 09-0460 to cover the Petition filing fee.

Please consider this a **PETITION FOR EXTENSION OF TIME** for a sufficient number of months to enter these papers, if appropriate.

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PETITION UNDER 37 C.F.R. §1.181

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BOX AF
Commissioner for Patents
Washington, D.C. 20231

OFFICIAL

Dear Sir:

This Petition is being submitted in accordance with M.P.E.P. §706.07(c) to invoke the supervisory authority of the Commissioner under 37 C.F.R. §1.181 involving an ex parte action in the above-identified patent application that is not subject to appeal and not otherwise provided for.

The Applicants request a review of the final rejection made in an Office Action dated March 22, 2001, for the above-identified patent application. This Petition is being submitted in response to the final office action.

The 35 U.S.C. § 103 rejections in the Office Action were made final, even though the rejections of the Office Action were based on a reference that was not cited in a previous Office Action on the

application and the amendments made to the claim merely incorporated claim limitations expressed in a dependent claim. The Examiner asserted that the Applicants' amendment necessitated the new grounds of rejection.

The Applicants' attorney disagrees. The Applicants' amendment of the claims merely amended the independent claims to incorporate dependent claim limitations. For example, the independent claims 1, 12, 23 were amended to include a limitation such that the element was transferred from a from to an HTML page and an HTML file associated with the HTML page, which limitation was incorporation from dependent claims 2, 13, and 24 respectively of the application as originally filed. The original dependent claims 2, 13, and 24 specifically provided "...the element is transferred from a from to the HTML page associated with the HTML file."

The amendments and arguments made in response to the first Office Action should reasonably have been expected by the Examiner, since the subject of the amendments were part of the specification and, more importantly, part of the claimed subject matter, of the application as originally filed. See M.P.E.P. §§ 706.07(a) and 904 et seq.

As such, it is respectfully submitted that the rejections should not be made final because the rejections of the second Office Action include rejections made on prior art not of records, and consist solely of included limitations which should reasonably have been expected to be claimed. As a result, it is erroneous, as a matter of law, to state that the Applicants' amendments were not reasonably expected by the Examiner and therefore necessitated the new grounds of rejection. Consequently, the final rejection was premature, and Applicants' attorney respectfully requests its withdrawal.

This Petition is being submitted by facsimile, and thus Applicants request that any required Petition fees be charged to the Deposit Account No. 09-0460 of IBM Corporation. Any other fees should be charged to Deposit Account No. 09-0460 as well.

Respectfully submitted,

Howard J. Glaser et al.

By their attorneys,

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